

Amendments to the Drawings:

The attached Sheet 2 of the drawings includes changes to FIG. 4 .
This sheet replaces the original Sheet 2 (FIG. 4).

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the May 30, 2006 Office Action. All claims were rejected based upon a citation of various prior art references. In response, Applicant has amended claims 1, 12 and 13; canceled claims 2-4, 8 and 14-27; and added new claims 28-45. Reconsideration and reexamination of the application, as amended, is respectfully requested.

SPECIFICATION

As indicated above, Applicant has included a more detailed description of the hook 42, which is clearly illustrated in FIGS. 4-9. The additional description is based upon the original description and the original drawings, and Applicant submits that no new matter has been entered.

DRAWINGS

Applicant submits herewith a revised FIG. 4, more clearly illustrating ramps 30. In the Office Action, the Examiner objected to the disc entry ramp 30 under 35 USC §112, as the Examiner asserted that it was unclear from the specification and the drawing as to what features and properties the disc entry ramp has other than being at the bottom of the housing. As described on the top of page 6, lines 1-4, one or more disc ramps 30 serve to guide the disc 12 into guide tracks 28 and out of the interior cavity 20. Replacement Sheet 2 (FIG. 4) more clearly illustrates these ramps 30 so that the features and properties of the disc entry ramp 30 are clear to one of ordinary skill in the art. Once again, Applicant respectfully asserts that no new matter has been added to the application as the disc ramps 30 were previously disclosed in the original specification and the drawings have been merely modified slightly so as to more clearly illustrate these.

35 USC §112 REJECTIONS

Claim 12 has been amended to depend from claim 11, thus providing antecedent basis for "the locking means". Claims 21, 26 and 27 have been canceled.

CLAIM REJECTIONS - 35 USC §102(e)

Claims 1, 3-5 and 8-11 were rejected under 35 USC §102(e) as being anticipated by either U.S. Patent No. 5,495,939 to Castritis, or U.S. Patent No. 4,728,157 to David.

Independent claim 1 has been amended to recite that disc guide tracks are formed in the housing for guiding the disc into and out of the interior cavity. Claim 1 has been amended to also recite that slider guide tracks are formed in the housing above the disc guide tracks. The manually-actuated slider moves along the slider guide tracks between a disc deployment position and a disc retrieval position. Independent claim 1 has further been amended to recite that the slider includes a hook extending therefrom resiliently pivotable along a vertical plane and configured to enter a central aperture of the disc from above the disc to retrieve the disc when the slider is moved into the disc retrieval position or at least a portion of the disc, and be forcibly removed from the disc aperture to release the disc when a pulling force is applied to the disc when the slider in a disc deployment position.

Neither Castritis nor David disclose disc guide tracks and slider guide tracks formed in the housing. Nor do Castritis or David disclose a hook extending from a slider resiliently pivotable along a vertical plane so as to enter a central aperture of the disc from above the disc to retrieve the disc, or be forcibly removed from the disc aperture to release the disc when a pulling force is applied to the disc. Instead, Castritis discloses a semi-circular boss 106 which extends upwardly from flange 103 and adapted to enter the conventional round pole provided in compact disc from below the disc, as illustrated in FIGS. 2 and 3 of Castritis. In the Office Action, the incline flap upper portion 88, which is disposed of acute angle to the bottom wall 86, of

David was asserted to comprise the hook structure of the present invention. However, this structure also enters the disc aperture from below the disc.

As illustrated and described in the Specification of the present application, the hook 42 extending from the slider 38 of Applicant's device enters into the aperture of the disc 12 from above the disc 12. In practicality, the lower edge of the hook 42 slides over the upper surface of the disc 12, until dropping into the aperture thereof. This is important as the top surface of compact disc, DVD's, and other such media bearing discs are not read from the top surface. Accordingly, scratches and the like to the top surface of the disc are of no consequence. However, scratching the lower surface of the disc will damage the disc and possibly prevent obtaining the songs or other data from the disc.

Moreover, Applicant notes that the device of the present invention enables the deployment of the disc, such as a CD into a CD player, as well as, the retrieval of the disc. Castritis and David are directed to ejectable compact disc containers or cases. Neither one is capable of retrieving a disc. However, with the hook/slider assembly arrangement of the present invention, both deployment as well as retrieval of the disc is possible.

Accordingly, Applicant respectfully submits that independents claims 1, 31 and 40 (and those claims depending therefrom) are patentably distinct from both the Castritis and David references.

New claims 28, 36 and 40 recite a raised lip surrounding a first aperture formed in the housing aligned with the disc aperture, and a second aperture formed in an opposite wall of the housing and adapted to receive the corresponding raised lip of the second housing stacked thereon. Neither Castritis nor David disclose such structure or function.

New claims 29, 38 and 40 recite that the housing has a generally flat edge defining the disc receiving aperture, and a generally rounded edge at an end generally opposite the disc receiving aperture. As described in the Specification, this is to assist the user, such as when it is dark, in determining opposite ends of the housing so as to properly hold the housing to deploy or

retrieve discs. The handgrip depressions formed in the housing (as recited in new claims 30, 39 and 40) also assist the user in determining the top and bottom surfaces of the housing so as to insert the disc into the reader or player properly. Neither the Castritis nor David references disclose these features either.

In the Office Action, Gloger (U.S. Patent No. 5,676,246) was combined with both Castritis and David as Gloger teaches a disc storage device that has disc tracks 30 formed in the housing 16. However, Gloger does not disclose disc guide tracks as well as slider guide tracks formed in the housing above the disc guide tracks. Moreover, Gloger does not disclose the hook, as recited in the independent claims, and is also merely a disc storage container having an ejector 118 for ejecting the disc from the container. There is no disclosure whatsoever which would enable retrieval of a disc, such as from a disc player in one's automobile.

Claim 12 was rejected under 35 USC §103(a) as being unpatentable over Castritis in view Spagna (U.S. Patent No. 6,896,133). Spagna teaches of a relatively complex locking pin arrangement which prevents a traditional compact disc jewel case or container from being opened, to prevent theft of the compact disc therein. This is a device which is intended to be used in a retail setting to prevent the opening and theft of CD's, DVD's and the like. A special device is required to unlock and remove the pin, which would not be realistic in the consumer setting. Moreover, Spagna does not disclose that its case either ejects or retrieves the disc, and fails to overcome the deficiencies of Castritis described above.

Claims 12, 13, 37 and 34 recite a case adapted to store multiple housings therein in stacked relation with a locking pin extending from one end of the case, through the aligned apertures of the multiple housings and discs, to an opposite end of the case. Either Castritis or David was combined with U.S. Patent No. 6,817,025 to Boorman and U.S. Patent No. 6,112,894 to Kikuchi in rejecting this claim. However, Applicant notes that neither Boorman

nor Kikuchi overcome the deficiencies of either Castritis or David, as described above respect to amended and new claims.

Moreover, Boorman is directed to a nesting optical disc holder wherein a plurality of disc containers, each container having generally opposite apertures aligned with an aperture of the disc, such that the holders can be stacked on a spindle of a support base. Kikuchi et al. describes a disc medium accommodating case, wherein a plurality of discs (not disc holders or deployment/retrieval devices) are stored within a housing having a central spindle or stacking column.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

The Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing In re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990). The mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). Applicant believes that impermissible hindsight was used in

reconstructing references in an attempt to reject the claims of the present application.

Neither Boorman nor Kikuchi disclose disc deployment/retrieval devices whatsoever. Instead, Boorman and Kikuchi disclose cases or holders for optical discs (without a surrounding container in the case of Kikuchi) or stacked disc containers having no deployment nor retrieval capabilities whatsoever. None of the cited references suggest the desirability of the modification as proposed by the Examiner. In fact, the teachings of Castritis or David in combination with Boorman and/or Kikuchi are only analogous to one another given the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Life Technologies, Inc. v. Clonetech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000).

In light of the foregoing amendments and remarks, Applicant respectfully asserts that the currently pending claims 1, 5-7, 9-13 and 28-45 are patentably distinct from the cited references and in condition for allowance, notice of which is hereby requested.

Respectfully submitted,

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